

### **REMARKS/ARGUMENTS**

1) Independent Claim 1 has been amended better to define the claimed invention and overcome the 35 U.S.C. 112, first paragraph rejection. Claims 2-5 depend from Claim 1. Accordingly, the 35 U.S.C. 112, first paragraph rejection, rejection of Claims 1-5 is overcome. Claims 13-17 have been canceled. Accordingly, the 35 U.S.C. 112, first paragraph rejection, rejection of Claims 13-17 is moot.

2) Claims 1-5 and 13-17 stand provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over the claims of U.S. Patent 6,665,277. Claims 1-5 and 13-17 stand provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over the claims of copending Application No. 10/606,816.

By this amendment Claim 1 has been amended such that it is not obvious over U.S. Patent 6,665,277 or over the claims of copending Application No. 10/606,816. Claims 2-5 depend from Claim 1. Accordingly, the double-patenting rejection of Claims 1-5 must be withdrawn. Claims 13-17 have been canceled. Accordingly, the double-patenting rejections of Claims 13-17 are moot.

3) Claims 1-4 and 13-16 stand rejected under 35 U.S.C. 102(b) as being anticipated by Nystrom et al. (U.S. Patent 6,185,244). Claims 13-16 have been

canceled so the rejection as to those claims is moot. Appellants respectfully traverse the rejection to Claims 1-5, as set forth below.

In order that the rejection of Claims 1-5 be sustainable, it is fundamental that "each and every element as set forth in the claim be found, either expressly or inherently described, in a single prior art reference." Verdegall Bros. v. Union Oil Co. of California, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). See also, Richardson v. Suzuki Motor Co., 9 USPQ2d 1913, 1920 (Fed. Cir. 1989), where the court states, "The identical invention must be shown in as complete detail as is contained in the ... claim".

Furthermore, "all words in a claim must be considered in judging the patentability of that claim against the prior art." In re Wilson, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970).

Independent Claim 1 requires and positively recites a method, comprising the steps of: "receiving a frame of data having a predetermined number of time slots, each time slot being adjacent another time slot", "receiving a plurality of data symbols in each respective time slot", "receiving a primary, a secondary and a tertiary synchronization code in each said predetermined number of time slots", "determining if one of N distinct code words or sequences is present in the tertiary synchronization code", "if one of N distinct code words or sequences is present in the tertiary synchronization code, synchronize the frame of data using tertiary synchronization code and detect a code word transmitted on the secondary synchronization code", **"if one of N distinct code words or sequences is not present in the tertiary synchronization code, synchronize the frame of data and identify code group using secondary synchronization code"**.

In contrast, Nystrom teaches a coding scheme for acquiring a long code and frame timing during a cell search in a CDMA communications system, but it fails to teach or suggest, **“if one of N distinct code words or sequences is not present in the tertiary synchronization code, synchronize the frame of data and identify code group using secondary synchronization code”**, as is required by Claim 1. Accordingly, the 35 U.S.C. 102(e) rejection of Claim 1 is overcome. The 35 U.S.C. 102(e) rejection of Claims 2-5 is similarly overcome since Claims 2-5 depend from Claim 1.

New independent Claim 28 is similarly allowable since it requires and positively recites, “searching for presence of a known code word in the tertiary synchronization code” and **“synchronizing the frame of data and identifying code group using the secondary synchronization code if a known code word is not detected”**, which is not taught or suggested by Nystrom. New Claims 29-37 depend directly, or indirectly, from Claim 28 and are similarly allowable.

New independent Claim 38 is also allowable since it requires and positively recites, “identifying the primary synchronization code” and **“using the tertiary synchronization code to provide both frame synchronization and partial synchronization code group identification”**, which is not taught or suggested by Nystrom. New Claim 39 depends from Claim 38 and is similarly allowable.

4) Claims 5 and 7 stand rejected as being unpatentable under 35 U.S.C. 103(a) as being unpatentable over Nystrom et al. (US Patent 6,185,244). Applicant respectfully traverses this rejection, as set forth below.

Claim 5 depends directly from Claim 1 and is allowable for the reasons set forth above in support of the allowance of Claim 1 over Nystrom.

In proceedings before the Patent and Trademark Office, "the Examiner bears the burden of establishing a prima facie case of obviousness based upon the prior art". In re Fritch, 23 USPQ2d 1780, 1783 (Fed. Cir. 1992) (citing In re Piasecki, 745 F.2d 1468, 1471-72, 223 USPQ 785, 787-88 (Fed. Cir. 1984). "The Examiner can satisfy this burden **only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references**", In re Fritch, 23 USPQ2d 1780, 1783 (Fed. Cir. 1992)(citing In re Fine, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988)(citing In re Lalu, 747 F.2d 703, 705, 223 USPQ 1257, 1258 (Fed. Cir. 1988)).

Although couched in terms of combining teachings found in the prior art, the same inquiry must be carried out in the context of a purported obvious "modification" of the prior art. **The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification.** In re Gordon, 733 F.2d at 902, 221 USPQ at 1127. Moreover, **it is impermissible to use the claimed invention as an instruction manual or "template" to piece together the teachings of the prior art so that the claimed invention is rendered obvious.** In re Gorman, 933 F.2d 982, 987, 18 USPQ2d 1885, 1888 (Fed.Cir.1991). See also Interconnect Planning Corp. v. Feil, 774 F.2d 1132, 1138, 227 USPQ 543, 547 (Fed.Cir.1985).

Furthermore, "all words in a claim must be considered in judging the patentability of that claim against the prior art." In re Wilson, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970).

Claims 25-27 depend directly from Claim 1 and are allowable for the same reasons set forth above in support of the allowance of Claim 1. Claims 29-37 depend directly, or indirectly, from Claim 28 and are allowable for the same reasons set forth above in support of the allowance of Claim 28. Claim 39 depends directly from Claim 38 and is allowable for the same reasons set forth above in support of the allowance of Claim 38.

Claims 1-5 and 25-39 stand allowable. Applicant respectfully requests withdrawal of the rejections and allowance of the application at the earliest possible date.

Respectfully submitted,



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